

**REMARKS**

This Amendment, submitted in response to the Office Action dated March 26, 2004, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

**I. Preliminary Matters**

***Drawings***

Pursuant to a telephonic discussion on April 14, 2004 between the above-identified Examiner and the undersigned Applicant's representative, the Examiner indicated that the drawings filed November 30, 2000 have been accepted. Therefore, Applicant respectfully requests that the Examiner indicate acceptance of the drawings in an Office Action Summary.

***IDS***

The IDS filed November 30, 2000 has not been signed and document EP 0 620 486 has not been initialed. During the telephonic discussion between the Examiner and the Applicant's representative, the Examiner indicated that a copy of EP 0 620 486 could not be located. Enclosed in a copy of EP 0 620 486. Consequently, Applicant respectfully requests that the Examiner initial document EP 0 620 486 and sign the IDS filed November 30, 2000.

**II. Specification**

The Examiner requests that the specification be checked for errors. The specification has been amended as indicated above.

**III. Rejection under 35 U.S.C. § 112, second paragraph**

The Examiner rejects claims 7, 10, 17, 22-23, 29, under 35 U.S.C. § 112, second paragraph, stating that the claims recite the limitation "the first image" and "the second image"

and “the read first”, however, there is insufficient antecedent basis for these limitations in the claims. Applicant has amended the claims as indicated above. The language “the read first” refers to the first image information and second image information which has been read, and therefore the language is in proper form. Consequently, the § 112 rejection of claims 7, 10, 17, 22-23, 29 should be withdrawn.

#### **IV. Rejections under 35 U.S.C. § 103(a)**

Claims 1-43 are now pending in the present application. Claims 22 and 28 have been allowed. Claims 4, 5, 9 and 21 have been objected to but would be allowed if rewritten in independent form. Claims 4, 5, and 9 have been rewritten in independent form. Consequently, they should be deemed allowable. Claims 34, 35 and 40 have been amended to include the subject matter of claim 41. Claim 41 has consequently been canceled.

Claims 1-3, 6, and 15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Edgar (US 5,519,510). Claims 7-8, 10-14, 16-19, 23, 25-26, 29, 31-32, 34-35, 37-41 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Edgar in view of Morton (US 5,639,580). Claims 20, 27 and 33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Edgar in view of Morton and further in view of Yoshikawa (US 5,081, 526). Claims 24, 30, and 36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Edgar in view of Morton as applied to claim 23 above, and further in view of Cottrell et al (US 5,408,447). Applicant submits the following in traversal of the rejections.

***Rejection of claims 1-3, 6, and 15 under § 103(a) as being unpatentable over Edgar***

***Claim 1***

The Examiner cites central processing unit (CPU) 10 for teaching processing the exposed color photosensitive material, as further recited in claim 1. The CPU is a conventional processor for workstation. Col. 2, lines 53-57. There is no indication that the CPU of Edgar processes exposed color photosensitive material. It would appear that the CPU processes data related to images stored on a photosensitive material and not the photosensitive material itself.

The Examiner states that Edgar does not teach processing the exposed photosensitive material at a processing temperature of 50°C or more to form a silver image and *reading the silver image*. The Examiner's reasoning is unclear since Edgar col. 8, lines 1-13 was cited for teaching reading the silver image. Applicant respectfully requests that the Examiner clarify this reasoning.

The Examiner also states that processing the temperature at 50°C or more to form a silver image is obvious as a matter of design choice. However, merely stating that an element is obvious design choice is insufficient to establish an obviousness rejection.

The use of per se rules, while undoubtedly less laborious than a searching comparison of the claimed invention -- including all its limitations -- with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. Per se rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on per se rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to Graham and its progeny, entitles an applicant to issuance of an otherwise proper patent

unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any per se rules of obviousness.... *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995).

In addition, Edgar describes “scanning the film during development at plural spaced time intervals” as an essential element as disclosed in Edgar claim 1. In other words, in Edgar, plural pieces of image information at different development stages are obtained from a film by scanning the film at plural development stages. Specifically, as shown in Fig. 3, the images are scanned three times, namely, as a long development scan, a normal development scan and a short development scan. In the system of Edgar, if one carried out the development at the processing temperature as high as 50°C, the development speed would become too high to scan plural images with a certain time intervals. In particular, a processing temperature as high as 50°C would spoil the invention of Edgar. Accordingly, one skilled in the art would not apply a processing temperature as high as 50°C to Edgar. Therefore, processing the temperature at 50°C or more is not obvious as a matter of design choice.

The Examiner also states that the claimed invention does not disclose that the temperature provides an advantage, is used for a particular purpose or solves a stated problem. Applicant refers the Examiner to page 95 as to the benefits of the claimed temperature. Moreover, it is well-settled that only results-oriented variables may be optimized. In the Edgar reference, the scan-development purports to eliminate bath processes, thereby rendering the temperature of any such process irrelevant. According to Edgar, one would not adjust a process

temperature but rather would change a scan wavelength, time, or intensity. Col. 6, lines 25-29 and lines 41-53.

For the above reasons, claim 1 and its dependent claims should be deemed patentable. Since claim 6 describes similar elements, claim 6 and its dependent claims should also be deemed patentable.

Furthermore, since the Examiner has not considered the infrared and density transmission described by claim 15, claim 15 should also be deemed patentable.

***Claim 2***

Claim 2 recites that 60% or more of the density of the image is based on the developed silver. The Examiner asserts that silver image films always show an increase along with density, citing col. 4, lines 14-26 of Edgar. However, there is no indication that 60% or more of the density of an image is based on the developed silver.

In addition, any indication by the Examiner that 60% or more of the density of the image is based on the developed silver would be an obvious design choice, would be improper for the reasons indicated above. Therefore, claim 2 should be deemed patentable.

***Rejection of claims 7-8, 10-14, 16-19, 23, 25-26, 29, 31-32, 34-35, 37-41 under §103(a) as being unpatentable over Edgar in view of Morton***

***Claim 7***

The Examiner asserts that Edgar teaches reading image information photoelectrically from the obtained image, the reading of image information comprises photoelectric reading of first image information by using light reflected from and photoelectric reading of second image information by light transmitted through the processed silver halide photosensitive material, and

the read first and second image information is converted into electrical blue, green and red digital image information, citing col. 8, lines 14-24 and Fig. 9.

The respective column and lines cited by the Examiner describe a duplex film processing system. Three layers sensitive to red, green or blue colors are placed over a clear base. Dark grains developing in the top layer, the blue source layer, are visible from the front of the film but are hidden from the rear. Grains in the bottom layer, the red sensitive layer, are visible from the back by reflected light but not from the front. Grains in the middle layer, the green sensitive layer, are visible alone with those in the other layer by transmitted light. By sensing the light reflected from the front, the back and light transmitted through the film each pixel in the film yields three measured numbers that may be solved for the three colors. The solution can use matrix regression.

However, there is no indication that read information is converted to electrical blue, green and red digital image information.

In addition, Morton relates to an integral image element comprising an integral lens sheet carrying convex surfaces of a plurality of lens elements (i.e. a lenticular lens sheet) (abstract, Fig. 1). The integral image element of Morton is utilized to obtain three-dimensional images having low flair, high resolution, low halation and good contrast. However, there is neither suggestion nor motivation for combining it with the disclosure of Edgar since these two disclosures are completely different technologies.

The Examiner states that Edgar does not teach that the silver halide color photosensitive material contains decolorizable anti-halation dye, and cites Morton to cure the deficiency. Further, the Examiner states that the combination of Edgar and Morton is obvious because it

would be easy to modify Edgar to include Morton and they share cumulative features that make them additive in nature. It would appear to be inefficient and a waste of resources if features of Edgar were duplicated to include features of Morton. This would evidence that the Examiner's reasoning is merely a result of hindsight.

Furthermore, as indicated on page 5, second paragraph of the specification for the present invention, the prior art discloses methods of improving reading accuracy by providing a reflective layer in a color film. However, the disclosed methods are not practical because general films distributed on the market cannot be used with these methods. Since Morton teaches the use of a reflective layer, Morton's teachings are contrary to the claimed invention. Although the reflective layer was not specifically cited, the Examiner may not merely pick and choose aspects of a reference for teaching claimed elements and must look at the references as a whole to determine what would be conveyed to one of skill in the art.

Therefore, claim 7 and its dependent claims should be deemed patentable.

The Examiner asserts that the arguments presented in rejecting claim 7 are also applicable to claims 10, 11, 16, 17, 23, 29, 34, 35, and 38-40. However, for example, claim 10 recites a silver halide color photosensitive material has at least one interlayer containing an infrared absorbing dye, claim 16 recites at least one interlayer containing an infrared absorbing dye having a transmission density of at least .5, claim 17 recites a silver halide clarification process, claims 23 describes drying between readings, claim 29 describes applying a developing solution to a silver halide color photosensitive material, which are not described in claim 7. The Examiner has not established where the claimed elements are taught in the prior art, nor does it appear that the cited prior art teaches the claimed elements.

For example, Edgar neither discloses nor suggests the feature that the silver halide color photosensitive material is dried between the reading operations of the first and second image information, as recited in claim 23. In Edgar, the film is scanned during development during plural time intervals. In other words, the film of Edgar is scanned while the developing solution is present on the film; i.e. while the film is wet. Thus, there is not drying process.

Therefore, claims 10, 11, 16, 17, 23, 29, 34, 35, and 38-40 should be deemed patentable or any subsequent Office Action should be made on a non-final basis due to the Examiner's failure to address all of the claims. MPEP 707.07(g).

***Claim 8***

Claim 8 recites that the electrical blue, green, and red digital image information obtained by conversion of the first and second image information is subjected to image processing and the image-processed digital image information is outputted to a printer. The Examiner cites Edgar col. 3, line 63 to col. 4, line 4 for teaching the elements of claim 8. The respective column and lines cited by the Examiner describe developing film in a dark room. There is no indication of first and second image information or that image-processed digital image information is outputted to a printer. Therefore, claim 8 should be deemed patentable. Since claims 12, 18, 25, 31 and 38 recite similar elements, they should be deemed patentable for the same reasons.

***Claim 37***

The Examiner cites Edgar col. 8, lines 25-56 for teaching exposed silver halide color photosensitive material being subjected to development process and then clarification process as recited in claim 37. However, there is no indication of a clarification process in the respective column and lines cited by the Examiner. Therefore, claim 37 should be deemed patentable.



***Rejection of claims 20, 27 and 33 under § 103(a) as being unpatentable over Edgar in view of Morton and further in view of Yoshikawa***

***Claim 20***

Claim 20 recites that the development process to which the silver halide color photosensitive material is subjected is black and white development and that the second image information is an image information obtained by reading light transmitted through the processed photosensitive material on which superposed images are formed on three layers comprising a lowermost photosensitive layer, an uppermost photosensitive layer, and an intermediate photosensitive layer.

The Examiner states that Edgar and Morton fail to teach the elements of claim 20 and cites Yoshikawa to cure the deficiency. However, the objective of Edgar is to enhance film development through the application of electronic imaging technology for *color images*. Col. 4, lines 30-35.

Furthermore, Yoshikawa does not describe second image information which is image information obtained by reading light transmitted through the processed photosensitive material on which superposed images are formed on three layers comprising a lowermost photosensitive layer, an uppermost photosensitive layer, and an intermediate photosensitive layer. In particular, there is no indication that light is transmitted through a processed photosensitive material nor is there any indication of a lowermost, uppermost and intermediate photosensitive layer, as recited in claim 20. At most, Yoshikawa discloses a multi-layer photosensitive material. Col. 1, lines 49-52.

The Examiner reasons that the combination of Edgar, Morton and Yoshikawa is obvious since the systems share cumulative features making them additive in nature. As previously indicated, the Examiner's reasoning would appear to be inefficient and redundant, evidencing that the Examiner's reasoning is merely a result of hindsight. Therefore, claims 20, 27 and 33 should be deemed patentable.

*Rejection of claims 24, 30, and 36 under § 103(a) as being unpatentable over Edgar in view of Morton and further in view of Cottrell*

***Claim 24***

Claim 24 recites that the silver halide color photosensitive material has a support mainly made from polyester. The Examiner states that Edgar and Morton do not teach the elements of claim 24 and cites Cottrell, col. 7, lines 39-59, to cure the deficiency. Again the Examiner reasons that the combination is obvious since the systems share cumulative features making them additive in nature. As previously indicated, the Examiner's reasoning would appear to result in a waste of resources, evidencing that the Examiner's reasoning is merely a result of hindsight. Therefore, claim 24, 30 and 36 should be deemed patentable. Furthermore, claims 24, 30 and 36 should be deemed patentable by virtue of their dependency to claims 23, 29 and 35 for the reasons set forth above.

Applicant has added claims 42 and 43 to further define the present invention.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
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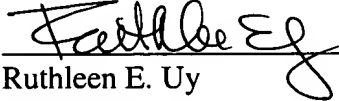
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**23373**

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